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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/580,377	05/22/2006	Reinhard Pinzer	06-328	2560
34704	7590	05/26/2009		
BACHMAN & LAPOINTE, P.C. 900 CHAPEL STREET SUITE 1201 NEW HAVEN, CT 06510			EXAMINER DELONG, CHAD D	
			ART UNIT 4131	PAPER NUMBER
			MAIL DATE 05/26/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/580,377	<b>Applicant(s)</b> PINZER ET AL.	
	<b>Examiner</b> CHAD DELONG	<b>Art Unit</b> 4131	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 24-46 is/are pending in the application.
- 4a) Of the above claim(s) 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 24-45 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>8/11/06 &amp; 5/22/06</u> .                                   | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Election/Restrictions*

1. The applicant has elected group I (claims 24-45) drawn to a preparation comprising at least one silicone, at least one PEG/PPG dimethicone, a lipid phase, a polar liquid, and at least one particulate substance. Claim 46 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention (group II), there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 05/07/09.

### *Priority*

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 24-27, 29-42, and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mondet et al (U.S. Patent Application Publication 2004/0223990) as evidenced by Carbopol 1342 product specification sheet and Dow Corning 3225C Formulation Aid specification sheet.

7. Mondet discloses a cosmetic composition for caring for and/or making up the skin or lips (paragraph [0002]). The composition can contain a fatty phase (paragraph [0090]) comprising a "volatile oil", including volatile silicone oils (hexamethyldisiloxane), from 0.1 to 98% of the composition (paragraphs [0104 and 0105]) (component **a** of claim 24 and claims 25, 30, and 31). The fatty phase can further comprise a "non-volatile" oil from 0.01 to 90% by weight (paragraph [0117]), including silicone hydrocarbon-based oils (claims 26 and 27) (paragraph [0106]) or hydrocarbon-based oils (lipid phase) of plant origin (sunflower oil) (paragraph [0109]) (component **c** of claim 24 and claims 32, and 33). Compositions can have a continuous fatty phase which can comprise in particular less than 5% by weight of water (paragraph [0093]) (component **d**

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of claim 24). The compositions can also have a particulate phase from 0.01% to 40% by weight including nacres (iridescent particles) and pigments (component **e** of claim 24 and claims 34, and 36) (paragraph [0193]). Additional fillers may be present from 0.01 to 40% by weight including zinc stearate (metal soap) and kaolin (an amorphous clay) (paragraph [0199]) (claims 35 and 37-39). For emulsion compositions, an emulsifying agent may be present in an amount from 0.2% to 30% by weight (paragraph [0154]), including silicone-based surfactants - DC 3225 (a PEG/PPG-18/18 dimethicone) (paragraph [0156]) (component **b** of claim 24). In addition, the compositions can further comprise antioxidants, preserving agents, and fragrances (claim 41). The emulsion can also contain polymers with emulsifying properties including Carbopol 1342 (a suspension agent) (paragraph [0159]). While the components listed above were not included in a single working example, it would have been prima facie obvious to a person having ordinary skill in the art to prepare a composition comprising at least one silicone, at least one PEG/PPG dimethicone, a lipid phase, a polar liquid and at least one particulate substance with a reasonable degree of success since they are all listed as possible components of the formulation disclosed in Mondet. The compositions can be in various forms, including a cast product (lipstick), more or less viscous liquid, gel, paste, solid or semi-solid (paragraphs [0214-0217]) (claim 42). While the viscosity is not defined, it is clear that the viscosity of the formulation can be modified to take on several forms (broad range of viscosities); therefore, the range of viscosities would overlap with the viscosities defined in claim 41 and in the case where the claimed ranges "overlap or

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lie inside ranges disclosed by the prior art” a prima facie case of obviousness exists – see MPEP 2144.05.

8. While Mondet discloses a preparation comprising at least one silicone, at least one PEG/PPG dimethicone, a lipid phase, a polar liquid, and at least one particulate substance, it does not disclose PEG/PPG-19/19 dimethicone as the emulsifier (claim 29), but discloses PEG/PPG 18/18 dimethicone as an emulsifier. It would have been prima facie obvious to a person having ordinary skill in the art to replace PEG/PPG 18/18 dimethicone with PEG/PPG-19/19 dimethicone since they are both known emulsifiers and essentially the same compound except for one less polyethylene glycol and polypropylene glycol subunit.

9. In regard to claim 44, Mondet discloses for emulsion compositions, an emulsifying agent may be present in an amount from 0.2% to 30% by weight (paragraph [0154]), including silicone-based surfactants - DC 3225 (a PEG/PPG-18/18 dimethicone) (paragraph [0156]). The composition can contain a fatty phase (paragraph [0090]) comprising a “volatile oil” from 0.1 to 98% of the composition (paragraphs [0104 and 0105]). The fatty phase can further comprise a “non-volatile” oil from 0.01 to 90% by weight (paragraph [0117]), including silicone hydrocarbon-based oils (paragraph [0106]) or hydrocarbon-based oils (lipid phase) of plant origin (sunflower oil) (paragraph [0109]). Compositions can have a continuous fatty phase which can comprise in particular less than 5% by weight of water (paragraph [0093]). The compositions can also have a particulate phase from 0.01% to 40% by weight including nacres (iridescent particles) and pigments (paragraph [0193]). The fatty phase may

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also contain pasty fatty substances and gums (thickeners) from 0.01% to 50% (paragraph [0119]). While Modet discloses all of the components of claim 44, some of the ranges overlap or lie within the ranges disclosed in the prior art. In the case where the claimed ranges “overlap or lie inside ranges disclosed by the prior art”, a prima facie case of obviousness exists – see MPEP 2144.05.

10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mondet et al (U.S. Patent Application Publication 2004/0223990) as evidenced by Carbopol 1342 product specification sheet and Dow Corning 3225C Formulation Aid specification sheet as applied to claims 24-27, 29-42, and 44 above, and further in view of Orrea (U.S. Patent Application Publication 2003/0095936).

11. While Mondet discloses a preparation comprising at least one silicone, at least one PEG/PPG dimethicone, a lipid phase, a polar liquid, and at least one particulate substance, it does not disclose a silicone comprising a C<sub>8</sub>-C<sub>20</sub> alkyl trimethicone.

12. Orrea discloses a lip gloss composition including one or more oils or oil-like emollients including laurytrimethicone (a C<sub>8</sub>-C<sub>20</sub> alkyl trimethicone) (paragraph [0019]).

13. It would have been prima facie obvious to a person have ordinary skill in the art at the time of the invention to modify Mondet to include laurytrimethicone, since it is a silicone-based oil and the formulation in Mondet includes silicone-based oils—see MPEP 2144.06 for combining equivalents known for the same purpose.

14. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mondet et al (U.S. Patent Application Publication 2004/0223990) as evidenced by Carbopol 1342 product specification sheet and Dow Corning 3225C Formulation Aid specification

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sheet as applied to claims 24-27, 29-42, and 44 above, and further in view of Patil et al (U.S. Patent Application Publication 2004/0213747).

15. While Mondet discloses a preparation comprising at least one silicone, at least one PEG/PPG dimethicone, a lipid phase, a polar liquid, and at least one particulate substance, and further including montmorillonite minerals (hectorite) (paragraph [0045]) from 0 to 20% by weight (paragraph [0085]), it does not disclose the preparation in the form of a thixotropic paste.

16. Patil teaches montmorillonite minerals hectorite and bentonite as thixotropic agents (paragraph [0110]). Using this information, the preparation in Mondet can be in the form of a paste and can contain thixotropic agents (hectorite). Therefore, it would have been prima facie obvious to a person having ordinary skill in the art to be able to formulate the preparation in Mondet as a thixotropic paste with a reasonable degree of success since the preparation in Mondet can contain a thixotropic agent and can be in the form of a paste.

17. Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mondet et al (U.S. Patent Application Publication 2004/0223990) as evidenced by Carbopol 1342 product specification sheet and Dow Corning 3225C Formulation Aid specification sheet as applied to claims 24-27 and 30-42 above, and further in view of Nichols et al (U.S. Patent 6,509,009).

18. While Mondet discloses a preparation comprising at least one silicone (non-volatile and volatile, at least one PEG/PPG dimethicone, a lipid phase, a polar liquid, and at least one particulate substance (coloring agent), also including an emulsifier, a



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suspension agent (Carbopol 1342) (paragraph [0159]), preserving agents, fragrances, and antioxidants (paragraph [0201]), it does not disclose further including a flavoring.

19. Nichols discloses a smear-resistant cosmetic (lipstick) that can contain a flavoring – sorbitol (a sugar substitute) (column 8 lines 53-58). The composition in Mondet can be formulated as a lipstick (paragraph [0004]). It would have been prima facie obvious to a person having ordinary skill in the art at the time of the invention to modify the invention (lipstick) disclosed in Mondet to include a flavoring to have the added benefit of making the lipstick taste sweeter.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAD DELONG whose telephone number is (571)270-1304. The examiner can normally be reached on Monday - Thursday 8:00a - 6:00p.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Nolan can be reached on 571-272-0847. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chad D. DeLong/  
Patent Examiner, Art Unit 4131

/Patrick J. Nolan/  
Supervisory Patent Examiner, Art Unit 4131